

Appln. No. 09/991,096
Amendment dated January 6, 2009
Reply to Office Action mailed May 13, 2008

REMARKS

Reconsideration is respectfully requested.

Claim 37 has been cancelled.

No claims are currently withdrawn.

No claims have been added.

Therefore, claims 1 through 36 and 38 remain in this application.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal. Claims 1, 10, and 12 have been amended to overcome the 25 USC 112 (second paragraph) rejection in the final Office Action. As the language substituted in the claims 1, 10, and 12 merely repeats the language in the preamble of the respective claims, it is submitted that the amendments to claims 1, 10 and 12 do not introduce new issues that require further searching or consideration. Therefore, it is submitted that the above requested amendments should be entered.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 2 of the Office Action

Claims 1, 10, 12, 20, 22 and 23 have been rejected under 35 USC. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the language "wherein the initial setup interaction between the user and the user personal computer occurs on the user personal computer being setup and occurs during the setup of the user personal computer" has been objected to.

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Although claims 1, 10, 12, 20, 22 and 23 have been rejected, only claims 1 and 10 include the language quoted in the rejection and claims 12, 20, 22, and 23 do not. Claims 1 and 10 have been amended to clarify the language of the claim, and recite language already in the preamble of the claims. It is noted that support and explanation for the term "out-of-box experience" can be found, for example, in the specification of the application at page 2, at paragraph [0003], which states:

[0003] To set-up an information handling system, the user may physically remove the information handling system from packaging, connect the physical components and then initiate start-up procedures. The out-of-box experience (OOBE) may refer to the process of establishing an information handling system or software program into an operating state.

And also at paragraph [0004], which states:

[0004] The OOBE provides insightful information because it is typically, one of the first interactions between the user and the information handling system, therefore the user may form opinions based on this experience. The user's opinions may carry over to their overall impression of the information handling system, the advice they convey to associates, and to future purchases they may make. Furthermore, difficulties occurring during the out-of-box process may trigger a help-line call which may lead to user anxiety and require costly help-line staffing.

In view of the above, it is submitted that the "out-of-box experience" terminology, which previously existed in claims 1 and 10 is supported in the specification.

Further, if the §112 rejection was intended to apply to claims 12, 20, 22, and 23 which did not include the language quoted in the rejection, it is respectfully requested that any further Action for this case explain what language of claims 20, 22, and 23 is found objectionable.

Withdrawal of the 35 USC 112, second paragraph rejection of claims 1, 10, 12, 20, 22 and 23 is respectfully requested.

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Paragraphs 3 through 6 of the Office Action

Claims 1 through 12, 14 through 17, 20 through 26, 29, 31 through 36 and 38 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Dean in view of Davis.

Claims 13, 18, 19, 27 and 28 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Dean and Davis as applied above and further in view of Official Notice.

Claim 30 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Dean.

Defect in rejection of claim 30

Initially, it is submitted that the §103 rejection of claim 30 is defective, as claim 30 depends from claim 1, and it is conceded in the §103 rejection of claim 1 that the Dean patent alone fails to disclose the requirements of claim 1 (e.g., uploading the detected user interaction data to a remote server and receiving that data by the remote server, as stated on the top of page 4 of the Office Action), and the rejection of claim 1 relies upon an allegedly obvious combination of Dean with Davis. The §103 rejection of claim 30 fails to indicate how Dean meets the aforementioned claim requirement in the rejection of claim 30 when it was conceded in the rejection of claim 1 that Dean fails to teach this requirements. As any attempt to discern the actual basis for the §103 rejection of claim 30 would require speculation in order to fully respond, it is requested that a further non-final Office Action (if a notice of allowance is not issued) be provided with a corrected (or at least further explained) line of argument for claim 30 should the rejection of claim 30 be maintained.

Claims 1 and 10

Claim 1 requires, in part, "wherein the initial setup interaction between the user and the user personal computer occurs on the user personal

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computer being setup and occurs during the user's out-of-box experience with the user personal computer". Claim 10 includes a similar but not identical requirement.

In the Response to Arguments section of the final Office Action, it is contended that (emphasis added):

In the remarks applicant argues in substance that; A) Dean does not teach the initial setup interaction between the user and the user personal computer occurs on the personal computer being setup and occurs during the setup of the user personal computer.

In response to A) Applicant is reminded that claim limitation must be given their reasonable broadest interpretation. The applicant is misinterpreting the Dean reference. Dean teaches installing programs, settings and configurations in a network of a plurality of server and client computers. The claim limitation "initial setup" is too broad. Every time an application or personal computer initializes is "initial setup". Dean teaches detecting user's interaction with the personal computer during initial configuration of the personal computer (See abstract, Fig. 4, Column 7, lines 11 -Column 8, lines 40). Therefore teaching of Dean meets the claimed limitation.

While it is not agreed that the term "initial setup" is too broad, or that one of ordinary skill in the art would recognize that the term has the breadth that is set forth in the rejection, it is noted that the section §112 clarification made in the language of claims 1 and 10 requires that the initial setup be "during the user's out-of-box experience with the user personal computer". This requirement, which was previously (and still is) set forth in the preamble of these claims, is defined in the specification of the application in at least paragraphs [0003] and [0004] as noted above.

Moreover, it is submitted that the clarified language of claims 1 and 10 make the "interpretation" of the "initial setup" terminology set forth in the Office Action inapplicable to the claim as a whole, as the language clarifies that the "initial setup" occurs "during the user's out-of-box experience with the user personal computer". Thus, the "initial setup" as defined in the claim does not occur "[e]very time an application or personal computer initializes" on the computer, as alleged in the Response text

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reproduced above. As the "out-of-box experience" is defined in the present application, the "initial setup" could not occur "[e]very time an application or personal computer initializes" because the "out-of-box experience" "is typically, one of the first interactions between the user and the information handling system".

Furthermore, the "initial setup" is further defined in the specification by the statement in paragraph [0003] that "[t]o set-up an information handling system, the user may physically remove the information handling system from packaging, connect the physical components and then initiate start-up procedures". This is also something that does not occur "[e]very time an application or personal computer initializes".

Now looking to the referenced portion of the Dean patent, it is clear that the Dean system is directed to the remote setting up of computers using a first computer to perform the "installation and configuration" for a second computer, for the express purpose that the second computer does not need to be utilized (and thus taken out of its normal operation) for the purposes of the "installation and configuration". (This in and of itself suggests that the Davis system is not used for an "initial setup" interaction, but some configuration action taken after the computer has already been put into operation.) As shown by the highlighted sections of the referenced portion reproduced below, the Dean patent discloses a system in which the configuration does not occur on the computer being configured, but another computer and then the configuration is simply downloaded to the computer being configured. Of course, this situation does not reflect the experience of the typical computer buyer and user.

The Dean patent states at col. 7, line 11 through col. 8, line 40 that (emphasis added):

In the description which follows, the data entry or prompt screen panel description with respect to FIGS. 4 through 27 and the programs described with respect to FIGS. 28 and 29, all relate to the

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development of the data file of sequential keystroke and cursor selection entries which will be subsequently used to load the selected programs and make the selected settings throughout the network of server and client computers. Although these figures are completely described in the copending Bezanson et al. application which is specifically directed to the development and use of such data files, the description and figures are repeated here so that the present patent will provide a unitary description of all aspects of the present invention. Thus, the screen of FIG. 4 asks the user to indicate whether the network installation is a new, "from scratch", configuration or a modification of an existing network configuration. Selection 71 indicates a new configuration. Selection 71 is stored in the primary server. FIG. 5 merely shows the screen which would have come up if the user chose to modify an existing network configuration. Since a new configuration was chosen, the screen of FIG. 6 comes up and the user enters all of his keystroke and cursor selections all of which are recorded in the primary server. These and the subsequent keystrokes and cursor selections will collectively provide the recorded data files of the present invention. It should be noted that with his selected entries 72 through 74, the user has chosen to install the same operating system for all clients, the same applications for all servers and the same applications for all clients. This should significantly reduce the subsequent entry strokes and cursor selections which need to be recorded since the same entry may be recorded and subsequently used for the multiple installations of the same applications. Then the screen of FIG. 7 solicits entries for setting up the desktop display environment for all of the client computers, after which the screen of FIG. 8 asks for networking configurations for the server computers such as e-mail groups and Internet workgroups and browser applications. Note that on the screen panel, the server indicator 79 is highlighted to show that the entries are applicable to the servers. In any event, all keystroke and cursor selection entries continue to be made into and stored in the primary server 50, FIG. 1. Next, through the screen in FIG. 9, entries selecting database management system for the servers are made. Then, through the display screen of FIG. 10, Internet functions and settings are customized for one of the servers, "Pilot", which is the primary server. Then, through screen panels displayed in FIGS. 12 and 13, the network browser application: "Navigator 3.01" and the database management applications respectively previously selected for the primary server, "Pilot", are customized. Next, FIG. 13, database application components and drivers are selected for the primary server computer through input to the display screen. Then, through the display screen of FIG. 14, network protocols and adapters are selected for all of the client computers. Note that the client indicator 76 is now highlighted to show that the keystroke and cursor selection entries being captured are

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now applicable to the client computers. Now, through the display panel shown in FIG. 15, one of the client computers, "Paco", is being configured with client settings relative to the windows application to be installed on it. Other client computers, "Newton" and "Jeff", are likewise individually configured as shown respectively in FIGS. 16 and 17. Next, the screen of FIG. 18 shows the entries made to configure TCP/IP network functions for all clients. This brings up the dialog panel of FIG. 19 wherein the IP addresses may be entered or modified for all clients. Next, the screen of FIG. 20, applications to be installed on all client computers are selected and more such selections are made through the screen of FIG. 21.

The screen of FIG. 22 shows the complete profile as represented by all of the applications loaded into the primary server and all of the keystroke and cursor selection entries stored in the recorded data file to configure a network made up of a primary server and three client computers. It should be obvious that similar profiles could have been developed for a network of several servers plus respective pluralities of client computers. FIG. 23 is the screen panel which is brought up after the user has reviewed the network profile of FIG. 22 to permit the user to save the profile. FIG. 24 is the screen dialog panel through which the user may use the entries described above for the subsequent installation and configuration of the network in accordance with the present invention; it will subsequently be discussed in greater detail.

In this previous description, we have described the entries made in the configuration of a network in which, for purpose of illustration, all of the same application programs were to be installed in all of the client computers. For purposes of completeness, we will now give an example of entries where different application programs are to be installed on different client computers. FIG. 25 is the screen panel of FIG. 6 except that the user has indicated by the absence of a selection in box 74 that the programs to be installed on all of the clients will not be the same for each client. This results in a sequence of individual selection panels, as typified by the screen panels of FIGS. 26 and 27 each respectively for the client, "Paco", and the client, "Newton", which permits the user to make individual program and related selections unique to each client.

The highlighted text above from the Dean patent establishes that the configuration of the computer being configured does not occur on the computer that is to be configured. This discussion in Dean is in contrast to the requirements of claim 1, which requires in part that "the initial setup interaction between the user and the user personal computer occurs on the user personal computer being setup and occurs during the user's out-of-box

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experience with the user personal computer". Claim 10 includes a similar, but not identical, requirement. Claim 12 requires "detecting, during the initializing of the personal computer by the user, data related to the user's interactions with the personal computer being initialized during the initialization of the personal computer occurring on that computer". Claim 20 requires "detecting an initialization interaction between a user and a user personal computer when the user initializes the user personal computer, the detection occurring during the initialization interaction between the user and the user personal computer, the initialization occurring on the user personal computer". Claim 22 requires "means for detecting an initialization activity on a personal computer by a user when the user is initializing the personal computer for a first use by the user of the personal computer" and "means for saving the initialization activity detected by said monitoring means to a file while the initialization activity is occurring on the personal computer".

The broad purpose of the present invention is to detect and record or store or transmit interaction between the user of the computer as that computer is being initially setup out of the box from the manufacturer, which (as is described in the patent application) can be a time of confusion and consternation for the user of the computer that has just been obtained by the user. Generally, the system of the invention is directed to a user personal computer and the initialization process performed by the user, and the problems that may occur during that process. The invention is thus highly suitable for the initialization of personal computers by a user that is not a part of an enterprise system that has access to servers on which configurations can be performed and saved on servers prior to the actual configuration.

The discussion in the Dean patent is in conflict with the above-noted requirements of the claims, as the keystrokes being recorded and saved in the Dean system occur on a different (first) computer from the (second)

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computer that is to be configured, and do not occur when the second computer is being configured, but occur sometime in advance of the configuration of the second computer while using the first computer. Thus, it is submitted that the Dean patent does not lead one of ordinary skill in the art to the requirements of the claims set forth above.

Further, claim 1 requires that "the user personal computer [is] configured to detect and upload data characterizing the interaction by the user with the user personal computer during the initial setup interaction with the user of the user personal computer", as well as requiring that "the initial setup interaction between the user and the user personal computer occurs on the user personal computer" (emphasis added). These features allow, for example, the manufacturer of the computer to be able to obtain objective feedback on the process of setting up the computer by the user of the computer, which is especially useful in the case of an inexperienced user setting up his or her own computer for the first time. The individual personal computer is often purchased and setup by a user that does not have all of the expertise of a computer professional. The feedback regarding the out-of-box-experience of the unsophisticated user may allow the manufacturer to determine ways of facilitating this initial setup by of computers by their inexperienced users.

The rejection of the claims, and particularly claim 1, is based upon the allegedly obvious combination of elements of the Dean and Davis systems. However, it is submitted that the Dean system lacks a significant requirement of claim 1. More specifically, the Dean patent does not disclose, for example, "detect[ing] and upload[ing] data characterizing the interaction by the user with the user personal computer during the initial setup interaction with the user of the user personal computer".

Thus, as is evident from the Dean patent, the purpose of the Dean system is to avoid having to configure the second computer while action

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using, or interacting with, the second computer. Instead, the configuration of the second computer is actually performed and recorded on the first computer for subsequent use on the second computer. This is clearly utilized by skilled Information Technology personnel, and is not for the relatively unsophisticated user to which the claimed invention is directed. It is submitted that this is in contrast with the requirements of claim 1, which requires that "the initial setup interaction between the user and *the* user personal computer occurs on *the* user personal computer", and thus does not occur on any personal computer other than the personal computer being set up.

It is noted that the general purpose of the Dean system to minimize the downtime of the second computer due to installation and configuration of the second computer. This purpose is set forth at col. 2, lines 11 through 21 of Dean, where it is stated that (emphasis added):

The present invention together with the above cross-referenced concurrently filed copending patent applications provide solutions which are directed to minimizing the time required for installation and configuration, as well as the significant upgrading of networks made up of a plurality of server computers having groups of client computers connected to each server computer. These inventions further minimize the number of computers in the network which have to be involved in each stage of an installation to thereby permit some of the system to remain functional for as long as possible during an upgrade.

More specifically, Dean discusses how this general purpose is attempted to be achieved—by performing the installation and configuration on a computer other than the computer to be configured—as is stated at col. 2, lines 31 through 39 (emphasis added):

One server computer having an interactive display interface is then designated as a primary server computer. Then, all of the interactive selection entries required to install all of the application programs and the driver programs which may be required to support said internal and external components of all of the other server and client computers in the network are then made into the interactive display interface of said primary server computer.

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This is further explained at col. 2, line 49 through col. 3, line 5 (all emphasis added):

The present invention uses the data files and other information developed during the preliminary processing which involved the primary server computer alone as covered by those two copending patent applications. The primary server loads all of the selected application programs onto their respective server and client computers and completes the network configuration under the control of the profile data file which is stored in the primary server computer. All of the selected programs to be installed throughout the network of server and client computers are first loaded into the primary server computer. Then, there is run the sequence of the keystroke and cursor entries required to install said selected components and programs on said server and client computers as recorded in a data file representative of said sequence of entries stored in said primary server computer. As a result, the programs and components are automatically loaded into the respective server and client computers in said network requiring said programs and components. The programs thus distributed include the operating systems for the server and client computers. Driver programs, as well as programs supporting various selected adapters such as network adapters, are preloaded and distributed throughout the network in this manner. Also, all network settings and other configurations are done in this way.

Thus, not only is the installation and configuration "keystrokes and cursor entries" performed on a computer different from the computer that is actually being installed and configured, the data collected from these entries are "automatically loaded" onto the client computer—there is no interaction between the client computer and the user of the client computer during this installation and configuration. Thus, there is no "out-of-box experience" of an initial setup configuration with the client computer of Dean.

It is therefore submitted that the Dean patent does not disclose "the user personal computer being configured to detect and upload data characterizing the interaction by the user with the user personal computer during the initial setup interaction with the user of the user personal computer", and that the Dean patent is more likely to lead one of ordinary skill in the art away from such a requirement, as the Dean system is clearly

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directed to moving installation and configuration operations to another computer in order to minimize the time that the computer being installed and configured is taken out of service. Instead, Dean proposes automatically loading these keystrokes and mouse entries that were recorded on another computer, which indicates that there is little or no "interaction:" between the user and the computer being installed and configured, which minimizes the downtime of that computer.

It is also noted that the Dean system is directed to computers that are already in operation and that are merely being reconfigured and new software being installed, and thus would not suggest an initial setup interaction or initialization of the computer, but an update process.

Claim 27

Turning now to claim 27, which depends from claim 1, it requires "wherein the data related to the user's interaction includes a screen capture". The rejection of claim 27 concedes that "Dean does not explicitly teach the claim limitation of screen capture," and then contends that:

However, "Official Notice" is taken that screen capture is old and well known in the art

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dean by adding screen capture, which will provide more user's interaction with the system to manufacturer. One would be motivated to do so to enhance the system's performance.

Even if one believes that "screen capture" is old and well known, it is submitted that one of ordinary skill in the art would not recognize that incorporating a screen capture function in the Dean system would "enhance the [Dean] system's performance". The rejection does not identify how one of ordinary skill in the art would recognize that adding a screen capture function to the Dean system would enhance performance. Furthermore, while the rejection asserts that "screen capture is old and well known in the art", the rejection does not identify anything that would inform one of

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ordinary skill in the art that "adding screen capture" "will provide more user's interaction with the system to the manufacturer. Further, since the Dean system is directed to remote configuration of a second computer without having to utilize the second computer during the configuration, the Dean system could not utilize a screen capture for the remote configuration on the first computer of the second computer in any useful manner. The rejection fails to explain how one of ordinary skill in the art would recognize that a screen capture would enhance the remote configuration of the second computer, especially since the person configuring the second computer is not working with the second computer during the time when the configuration is being done on the (remote) first computer.

Claim 28

Claim 28, which depends from claim 1, requires that "the data related to the user's interaction comprises data about a time period that a dialog box is open during the initial setup of the user personal computer", and it is conceded in the rejection that "Dean does not explicitly teach the claim limitation of data about a time period that a dialog box is open". It is then contended in the rejection that:

However, "Official Notice" is taken that data about a time period that a dialog box is open is old and well known in the art

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dean by adding functionality for collecting data about a time period that a dialog box is open, which will provide more user's interaction with the system to manufacturer. One would be motivated to do so to enhance the system's performance.

It is contended that the taking of Official Notice that "data about a time period that a dialog box is open is old and well known in the art" is not appropriate here. Moreover, even if one believes that "data about a time period that a dialog box is open is old and well known in the art", that "knowledge" does not inform one that "adding functionality for collecting data about a time period that a dialog box is open" "will provide more user's interaction with the system to manufacturer", and will "enhance the

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system's performance" as alleged in the rejection. The rejection provides no line of reasoning explaining how one of ordinary skill in the art would come to recognize that collecting and transmitting data regarding "a time period that a dialog box is open during the initial setup" would "enhance [Dean's]" system performance. The rejection does not provide any explanation of why it would make any difference to a "manufacturer" how long a dialog box is open since the Dean system does not involve or mention any role of a manufacturer in the system.

Claim 30

With respect to claim 30, which requires that "the data related to the user's interaction comprises data about a utilization of a "HELP" button during the initial setup of the user personal computer", the rejection concedes that "Dean does not explicitly teach the claim limitation of "HELP" button", but then it is alleged that:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dean by adding "HELP" button, which will make the system more users friendly. One would be motivated to do so to enhance the system's usability.

However, it is submitted that the rejection of claim 30 does not present a prima facie case of obviousness, as it is not established in the rejection that the "HELP" button in the context of the Dean system is even known. Further, the rejection does not establish that it was understood by those of one of ordinary skill in the art (at the time of the invention) that the incorporation of a "HELP" button provides the advantages alleged in the rejection. It appears from the text of the rejection that the Patent Office envisions a HELP button that makes the system more "user friendly" and "usable", but the rejection does not establish that one of ordinary skill in the art was aware of such a button which these advantages at the time of the invention.

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More importantly, the rejection of claim 30 appears to be directed solely to the inclusion of a button marked "HELP, and not to the entire requirement that "data about a utilization of a "HELP" button during the initial setup of the user personal computer" is the data that is detected and uploaded data which characterizes the interaction by the user with the user personal computer during the initial setup interaction with the user of the user personal computer as required by claim 1.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Dean, Davis and the Official Notice set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 10, 12, 20, 22 and 23. Further, claims 2 through 4, 6, 8, 9, 25, 26 through 31 which depend from claim 1, claims 5, 7 and 11, which depend from claim 10, claims 13 through 18, which depend from claim 12, claim 19, which depends from claim 18, claim 21, which depends from claim 20 and claim 24, which depends from claim 23 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1 through 36 and 38 is therefore respectfully requested.

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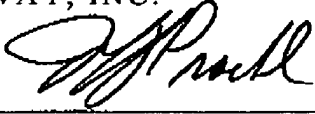
CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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